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BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

In re Application of :
Luo et al. :
Serial No.: 10/616,101 : PETITION DECISION
Filed: July 8, 2003 :
Attorney Docket No.: RIGL-010CIP3 :

This is in response to the petition under 37 CFR § 1.181, filed February 26, 2007, requesting that the finality of the Office action of January 5, 2007 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on May 26, 2006, setting a three month shortened statutory period for reply. In this action, claims 38-44 were rejected under 35 U.S.C. 112, second paragraph as being indefinite and rejected under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification and for being non-enabling. Claims 38-40 and 42 were rejected under 35 U.S.C. 102 (b) as being anticipated by Simonin et al., and claims 41, and 43-44 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Simonin et al., and further in view of Smith et al. and the common knowledge in the art.

In response to the non-final Office action of May 26, 2006, applicants amended claims 38-41 and 44. Applicants also argued the rejections set forth in the action.

The examiner mailed a final Office action on January 5, 2007, setting a three month shortened statutory period for reply. In this Office action, claims 38-40 and 42 were rejected under 35 U.S.C. 102 (e) as anticipated over Christenson et al., Daly et al., Geron Corp, or Berthelsen et al. Claims 41, and 43-44 were also rejected under 35 U.S.C. 103 (a) as unpatentable over any one of Christenson et al., Daly et al., Geron Corp, or Berthelsen et al., and further in view of Smith et al. and the common knowledge in the art. The rejection of claims 38-44 under 35 U.S.C. 112, first and second paragraph was withdrawn.

In response thereto, applicants filed this petition on February 26, 2007, requesting that the finality of the Office action of January 5, 2007 be withdrawn.

DISCUSSION

Applicants argue the Office action of January 5, 2007, sets forth four new grounds of rejections under 35 U.S.C. 102 (e) and is, thus, improperly final. Specifically, applicants point out the examiner states that the Office action is final because "Applicants' amendment necessitated the new ground(s) of rejection presented in this Office Action." Applicants acknowledge that the claims were amended but disagrees that the amended claims triggered the new grounds of rejection.

Applicants' argument is not persuasive. The claims filed on August 28, 2006 in response to the first Office action were essentially drawn to any composition comprising any recombinant tankyrase H protein and were not limited to any specific SEQ ID NO. Because the original claims were not limited to any specific SEQ ID NO, the examiner's search of the non-sequence database itself yielded the best available prior art. Because applicant did not include specific SEQ ID NO in the claims, it did not require the examiner to initiate the search for a SEQ ID on sequence databases. As stated above, the examiner used the best available prior art for those claims, under 35 USC 102(b), which placed a statutory bar, in order to reject those claims. In response to that rejection, applicants amended the claims to recite specific SEQ ID NO which also overcame the rejection under 35 USC 102(b). The inclusion of the specific SEQ ID NO in the amended claims triggered a new search of the sequence databases which yielded the new references that the examiner used to reject those claims. Applicants could have presented the SEQ ID NO in the claims before the examiner issued the first non-final rejection. In view of the above, the Office action of January 5, 2007 was properly made final.

DECISION

The petition is **DENIED**. Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Bruce Kishuk
Director, Technology Center 1600